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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,683	02/20/2004	Takato Oda	2004-0225A	3678
513	7590	09/22/2004	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			NINO, ADOLFO	
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SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			2831	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,683

Applicant(s)

ODA, TAKATO

Examiner

Adolfo Nino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Objections

Claims 1-4 and 6 are objected to because of the following informalities:

Claim 1, lines 2-3, replace "both" with ---two---.

Claims 2-4 and 6, line 2, respectively, "groove" should be plural.

Claim 6, line 4, "said groove is formed in one of said opposing side plates" is confusing because it reads as if there is more than one opposing side plates.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 4-6, "wherein engagement grooves....are formed in said upper plate" is confusing because according to the specification and/or drawings no engagement grooves are formed in said upper plate.

Claim 2 recites the limitation "its rear end" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "its rear end" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "said groove" in line 4. There is insufficient antecedent basis for this limitation in the claim.

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Claim 7 recites the limitation "said engagement groove" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Criniti et al. (US 6,730,845 B1).

Regarding claim 1 (Original), Criniti et al. disclose a cover support structure (10, 20) of a shield case including a case main body (10) having a bottom plate (16), both side plates (14) and a back plate (18) and a cover (20) having an upper plate (26) and both side plates (22) for covering said case main body, for supporting said cover in such a fashion as to prevent said cover from turning down when said cover is opened, wherein engagement grooves (106 in figs. 4, 5) capable of meshing with said back plate and/or said side plates of said case main body are formed in said upper plate and/or said side plates of said cover so that said cover can be kept upright while said engagement grooves are meshed with said back plate or said side plates of said case main body. **Note** that it has been held that the recitation that an element is "capable of"

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performing and/or "can" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. **Moreover, note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 2 (Original), as best understood by the Examiner, Crininti et al. disclose a cover support structure of a shield case according to claim 1, wherein said engagement groove (106) is a slit groove (figs. 4, 5) formed by cutting at least one of said side plates of said cover from its rear end and forming a slit and capable of meshing with said back plate of said case main body. **Note** that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it, which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985). **And** note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claim 3 (Original), as best understood by the Examiner, Criniti et al. disclose a cover support structure of a shield case according to claim 1, wherein said

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engagement groove (106) is a slit groove (figs. 4, 5) formed by the steps of cutting up a part of said upper plate of said cover inwardly, disposing a support plate at one or more positions, cutting said support plate from its rear end and forming a slit, and capable of meshing with said back plate of said case main body. **Note** that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it, which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985). **And** note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claim 4 (Original), as best understood by the Examiner, Criniti et al. disclose a cover support structure of a shield case according to claim 1, wherein said engagement groove (106) is a slit groove (figs. 4, 5) formed by cutting up one of said side plates of said cover from its rear end and forming a slit, and a slit groove formed by forming a slit in a support plate loaned by cutting up said upper plate on the side of the other of said side plates, and both of said slit grooves can mesh with said back plate of said case main body. **Note** that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. During examination, the patentability of a product-by-process claim

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is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it, which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985). **And** note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claim 5 (Currently Amended), **note** that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it, which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Regarding claim 7 (Original), as best understood by the Examiner, Critini et al. disclose a cover support structure of a shield case according to claim 1, wherein a non-circular projection (70 in fig. 3) is formed in at least one of said side plates of said case main body, and said engagement groove is a groove formed by cutting a slit on at least one of said side plates of said cover from its rear end in such a shape that said non-circular projection can fit when said cover is under horizontal and vertical conditions. **Note** that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the

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process for making it, which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985). **And** note that it has been held that the recitation that an element is "can" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claims 8-10 (New), **note** that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it, which is recited in the claim. In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Allowable Subject Matter

Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art does not disclose, teach or suggest, alone or in combination, the combination of an engagement groove formed in at least one side of a pair of side plates of a cover wherein the engagement groove protrudes outwardly and opens upwardly; and a circular cylindrical projection formed in one side of a pair of side plates of a case main body fits into said engagement groove making said cover turnably and

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removably attached wherein said circular cylindrical projection being an axis for which said cover turns at.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bang et al. (US 6,700,776 B2) disclose a computer. Chen et al. (US 6,654,236 B2) disclose a computer enclosure. Carr (US 6,498,727 B2) discloses a computer chassis breakaway door. Tai (US 6,259,025 B1) discloses an electrical fixture. Wei et al. (US 6,246,578 B1) disclose a computer access device. Engel (US 6,169,653 B1) discloses a latch and locate cradle. Moss et al. (US 6,144,549) disclose a flat panel display module for computer. Korhonen (US 6,121,549) discloses a holder for mounting a plate. Wallace et al. (US 5,933,328) disclose a compact mechanism. Reichow et al. (US 5,272,297) disclose a disconnect switch. Vogt et al. (US 5,162,978) disclose a frame support.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adolfo Nino whose telephone number is (571) 272-1981. The examiner can normally be reached on M-F (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on (571) 272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AN

 9/20/04
DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800